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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,973

07/18/2006

Yuehui Zhou

102699-102

7575

8015 7590 10/09/2008

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EXAMINER

SHIAO, REI TSANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

10/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,973	<b>Applicant(s)</b> ZHOU ET AL.	
	<b>Examiner</b> REI-TSANG SHIAO	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/21/05, 6/18/08, 8/19/08</u> .                               | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This application claims benefit of the foreign applications:  
CANADA 2398682 with a filing date 08/16/2002.
2. Claims 1-13 are pending in the application.

***Information Disclosure Statement***

3. Applicant's Information Disclosure Statements filed on January 21, 2005, June 18, 2008, and August 19, 2008 have been considered. Please refer to Applicant's copies of the 1449's submitted herein.

**4. *Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the limitation of the variable R<sup>10</sup>, see line 9. Correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

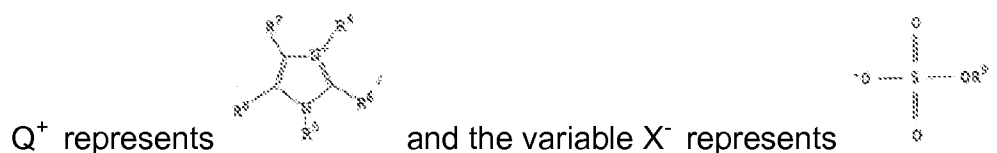
Claims 1-13 are rejected under 35 U.S.C. 102(a) as being anticipated by (1)

Wasserscheid et al. CAS: 136:200188; (2) Holbrey et al. CAS: 138:338049; or

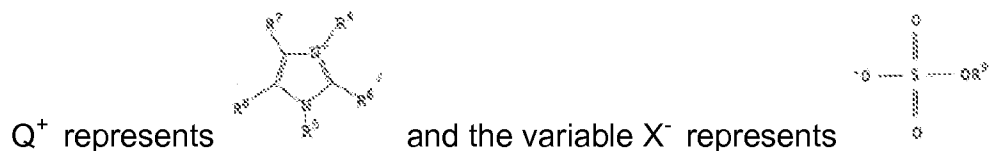
(3) Wasserscheid et al. CAS:140:78757.

Applicant claim compounds of formula (I), i.e.,  $Q^+X^-$ , and their processes of making, see claim 1 or 7.

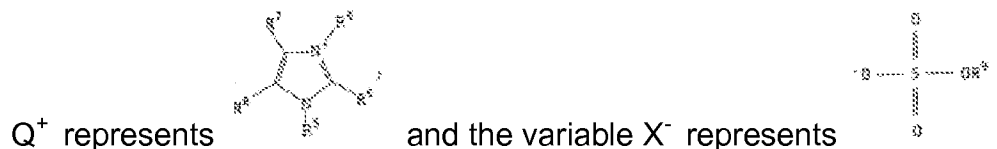
Wasserscheid et al. '188 disclose two compounds, see RN: 97345-90-9 or 401788-98-5. They clearly anticipate the instant compounds of formula (I), wherein the variable



Holbrey et al. disclose a compound and its process, see product of RX(1). It clearly anticipates the instant compounds of formula (I), wherein the variable



Wasserscheid et al. '757 disclose a compound and its process, see RX(1). It clearly anticipates the instant compounds of formula (I), wherein the variable



Dependent claims 2-6 and 8-13 are also rejected along with claim 1 or 7 under

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35 U.S.C. 102(a).

### ***Double Patenting***

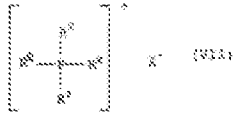
6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

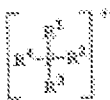
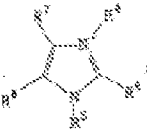
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

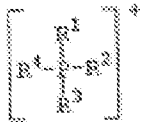
Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 or 30 of Zhou et al. co-pending application No. 10/549,223. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

Applicants claim compounds of formula (I), i.e.,  $Q^+X^-$ , and their processes of making, see claim 1 or 7.

Zhou et al. '223 claim compounds of formula (VII), i.e.,  and their processes of making, see claim 1 or 30.

The difference between instant claims and Zhou et al. '223 is that the instant

variable  $Q^+$  represents  or , while Zhou et al. '223 represents

 at the same position. Zhou et al. '223 compounds and their processes of making overlap with the instant invention.

One having ordinary skill in the art would find the claims 1-13 *prima facie* obvious because one would be motivated to employ the compounds and their processes of Zhou et al. to obtain instant compounds of formula (I) and their processes of making.. Dependent claims 2-13 are also rejected along with claim 1 under the obviousness-type double patenting.

The motivation to make the claimed processes derived from the known compounds and processes of Zhou et al. would possess similar activity (i.e., ionic liquids) to that which is claimed in the reference.

This is a provisional obviousness-type double patenting rejection because the

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conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.  
Primary Patent Examiner  
Art Unit 1626

September 25, 2008